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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/500,132	02/08/2000	Kiyoshi Iseki	11197/1	2161

7590 06/17/2005

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EXAMINER	
SIMONE, CATHERINE A	

ART UNIT	PAPER NUMBER
1772	

DATE MAILED: 06/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/500,132	ISEKI ET AL.	
	Examiner	Art Unit	
	Catherine Simone	1772	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *24 May 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-3,20 and 21* is/are pending in the application.

4a) Of the above claim(s) *20* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-3 and 21* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *5/24/05*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5/24/05 has been entered.

Election/Restrictions

2. Newly submitted claim 20 is directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the product as claimed in claims 1-3 and 21 can be made by another and materially different process without the steps of the process claimed in claim 20, i.e. obtaining data of the thickness of the inorganic oxide layer formed on the plastic film running in a vacuum chamber in a transverse and longitudinal direction of the plastic film by a plurality of X-ray measuring means etc.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution

on the merits. Accordingly, claim 20 is withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 1-3 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Misiano et al. (5,462,779).

Misiano et al. discloses a functional roll film comprising a transparent plastic film having gas properties (Fig. 1, #10 or Fig. 2, #20), and having an inorganic oxide layer on at least one surface (Fig. 1, #12 or #11, or Fig. 2, #21) wherein the inorganic oxide layer comprises a composite oxide having at least two components (Fig. 2, #21). However, Misiano et al. fails to disclose the maximum thickness of the inorganic oxide layer being equal to or less than 1.5 times the minimum thickness of the inorganic oxide layer among layer thickness values measured in one roll unit of the plastic film and the roll unit containing a film having a width of at least 400 mm and a length of at least 4,000 m and a width of at least 1,000 mm and a length of at least 15,000 m, and the difference between a maximum wt% and a minimum wt% of one component of the composite oxide in the one roll unit of the plastic film being within 20 wt%. Misiano et al. does teach the inorganic oxide layer having a uniform thickness (see col. 2, line 20). Therefore, the optimum range for the maximum thickness of the inorganic oxide layer and the optimum

range for the wt% of one component of the composite oxide would be readily determined through routine experimentation by one having ordinary skill in the art depending on the desired end results as shown by Misiano et al. Thus, it would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have modified the thickness of the inorganic oxide layer in Misiano et al. to have a maximum thickness equal to or less than 1.5 times the minimum thickness of the inorganic oxide layer and to have modified the wt% of the one component of the composite oxide in Misiano et al. to have the difference between a maximum wt% and a minimum wt% within 20 wt%, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art in absence of showing unexpected results. See MPEP 2144.05 (II).

Furthermore, one of ordinary skill in the art would have recognized the length and width of a packaging film to be sized depending on the object that is being packaged. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have the packaging film of Misiano et al. be sized to having a width of at least 400 mm and a length of at least 4,000 m or a width of at least 1,000 mm and a length of at least 15,000 m, since the size would depend on the object being packaged. Additionally, it has been held that claims directed to a lumber package "of appreciable size and weight requiring handling by a lift truck" were held unpatentable over prior art lumber packages which could be lifted by hand because limitations relating to the size of the package were not sufficient to patentably distinguish over the prior art. *In re Rose*, 220 F.2d 459, 105 USPQ 237 (CCPA 1955).

5. Claims 1-3 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Imai et al. (5,378,506).

Imai et al. discloses a functional roll film comprising a transparent plastic film having gas properties (see col. 5, lines 54-61), and having an inorganic oxide layer on at least one surface (see col. 6, lines 36-41) wherein the inorganic oxide layer comprises a composite oxide having at least two components (see col. 6, lines 40-41). However, Imai et al. fails to disclose the maximum thickness of the inorganic oxide layer being equal to or less than 1.5 times the minimum thickness of the inorganic oxide layer among layer thickness values measured in one roll unit of the plastic film and the roll unit containing a film having a width of at least 400 mm and a length of at least 4,000 m and a width of at least 1,000 mm and a length of at least 15,000 m, and the difference between a maximum wt% and a minimum wt% of one component of the composite oxide in the one roll unit of the plastic film being within 20 wt%. Imai et al. does teach the inorganic oxide layer having a uniform thickness (see col. 8, lines 12-14). Therefore, the optimum range for the thickness of the inorganic oxide layer and the optimum range for the wt% of one component of the composite oxide would be readily determined through routine experimentation by one having ordinary skill in the art depending on the desired end results as shown by Imai et al. Thus, it would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have modified the thickness of the inorganic oxide layer in Imai et al. to have a maximum thickness equal to or less than 1.5 times the minimum thickness of the inorganic oxide layer and to have modified the wt% of the one component of the composite oxide in Imai et al. to have the difference between a maximum wt% and a minimum wt% within 20 wt%, since it has been held that where the general conditions of a claim are

disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art in absence of showing unexpected results. See MPEP 2144.05 (II).

Furthermore, one of ordinary skill in the art would have recognized the length and width of a packaging film to be sized depending on the object that is being packaged. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have the packaging film of Imai et al. be sized to having a width of at least 400 mm and a length of at least 4,000 m or a width of at least 1,000 mm and a length of at least 15,000 m, since the size of the film would depend on the object being packaged. Additionally, it has been held that claims directed to a lumber package "of appreciable size and weight requiring handling by a lift truck" were held unpatentable over prior art lumber packages which could be lifted by hand because limitations relating to the size of the package were not sufficient to patentably distinguish over the prior art. *In re Rose*, 220 F.2d 459, 105 USPQ 237 (CCPA 1955).

3. Claims 1-3 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matsuda et al. (JP 06-330318; refer to computer translation).

Matsuda et al. discloses a functional roll film comprising a transparent plastic film (Drawing 2, #4) having gas properties, and having an inorganic oxide layer on at least one surface (Drawing 2, #16) wherein the inorganic oxide layer comprises a composite oxide having at least two components (see page 5, paragraph 0033, lines 1-5). However, Matsuda et al. fails to disclose the maximum thickness of the inorganic oxide layer being equal to or less than 1.5 times the minimum thickness of the inorganic oxide layer among layer thickness values measured in one roll unit of the plastic film and the roll unit containing a film having a width of at least 400 mm and a length of at least 4,000 m and a width of at least 1,000 mm and a length of at least

15,000 m, and the difference between a maximum wt% and a minimum wt% of one component of the composite oxide in the one roll unit of the plastic film being within 20 wt%. Matsuda et al. does teach the inorganic oxide layer having a uniform thickness (see page 4, lines 1-5). Therefore, the optimum range for the thickness of the inorganic oxide layer and the optimum range for the wt% of one component of the composite oxide would be readily determined through routine experimentation by one having ordinary skill in the art depending on the desired end results as shown by Matsuda et al. Thus, it would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have modified the thickness of the inorganic oxide layer in Matsuda et al. to have a maximum thickness equal to or less than 1.5 times the minimum thickness of the inorganic oxide layer and to have modified the wt% of the one component of the composite oxide in Matsuda et al. to have the difference between a maximum wt% and a minimum wt% within 20 wt%, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art in absence of showing unexpected results. See MPEP 2144.05 (II).

Furthermore, one of ordinary skill in the art would have recognized the length and width of a packaging film to be sized depending on the object that is being packaged. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have the packaging film of Matsuda et al. be sized to having a width of at least 400 mm and a length of at least 4,000 m or a width of at least 1,000 mm and a length of at least 15,000 m, since the size of the film would depend on the object being packaged. Additionally, it has been held that claims directed to a lumber package "of appreciable size and weight requiring handling by a

lift truck" were held unpatentable over prior art lumber packages which could be lifted by hand because limitations relating to the size of the package were not sufficient to patentably distinguish over the prior art. *In re Rose*, 220 F.2d 459, 105 USPQ 237 (CCPA 1955).

Response to Arguments

4. Applicant's arguments filed 2/24/05 have been fully considered but they are not persuasive. Applicants argue that "Applicants have discovered that the claimed film with the thickness ratio of 1.5 or less provides a preferred gas barrier property, along with flexibility and transparency, without increased production costs. These unexpected results cannot be determined from Misiano, Imai, or Matsuda, individually or in combination. Therefore, for at least these reasons, claims 1-3 are patentably over these references."

However, it is to be pointed out that "the arguments of counsel cannot take the place of evidence in the record." *In re Schulze*, 346 F.2d 600, 602, 145 USPQ 716, 718 (CCPA 1965). See MPEP 716.01(c).

Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Catherine Simone whose telephone number is (571)272-1501. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on (571) 272-1498. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Catherine A. Simone
Examiner
Art Unit 1772
June 10, 2005

HAROLD PYON
SUPERVISORY PATENT EXAMINER
1772

6/10/05